

Appl. No. 10/828,572
Resp. AF dated August 8, 2006
Reply to Final Office Action of June 8, 2006

REMARKS

Applicants have carefully reviewed the Final Office Action mailed on June 8, 2006. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claims 1-7, 9-20 and 22-35 remain pending.

Claim Rejections under 35 U.S.C §103

Claims 1, 7, 9, 11, 12, 14, 20, 26, 27, 29 and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knorig in U.S. Patent No. 6,264,633 in view of Termin et al. in U.S. Patent No. 5,221,261. The requirements of a prima facie case of obviousness are set forth in §2143 of the MPEP:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, (Fed. Cir. 1991).

Turning now to the primary reference, Knorig does not teach or suggest that it would be desirable to dispose a tubular fixation element (e.g., like the tubular fixation element 22 disclosed by Termin et al.) adjacent to balloon 11. Conversely, nothing in Termin et al. suggests it would be desirable to add the structured outer surface 12 of the Knorig balloon to the Termin et al. balloon 11. In addition, nothing in either of the references suggest that it would be desirable to somehow add a structured outer balloon surface (e.g., like structured outer surface 12 disclosed by Knorig) to a tubular fixation element (e.g., like the tubular fixation element 22 disclosed by Termin et al.) in order to defeat the patentability of claims 1, 7, 9, 11, 12, 14, 20, 26, 27, 29 and 35. Therefore, the cited references fail to provide a reasonable motivation to combine the respective teachings in order to arrive at the claimed invention.

Moreover, if the structured outer surface 12 of the Knorig balloon was altered so as to have free proximal ends, the likely result is failure of the balloon because doing so would likely

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weaken the balloon at locations where portions were removed in order to create the free proximal ends. This suggest that combining Knorig with Termin et al. is improper because there would not be a reasonable expectation of success.

Furthermore, even if the Termin et al. balloon 11 had a structured outer surface (like surface 12 in Knorig), the combination does not teach or suggest a traction member having a free proximal end. Thus, even if it was proper to combine Knorig with Termin et al., the resultant combination would still fail to teach or disclose each and every claim limitation.

The forgoing comments indicate that a prima facie case of obviousness has not been properly established for claims 1, 7, 9, 11, 12, 14, 20, 26, 27, 29 and 35 in view of Knorig and Termin et al. Consequently, this rejection should be withdrawn in due course.

Please note that claims 13 and 25 are not listed in the rejection put forth by the Examiner at paragraph 2 on page 2 of the Office Action. However, the Examiner referenced these claims in paragraph 3 on page 2 of the Office Action and, therefore it is assumed that the Examiner intended to reject these claims as well as those listed above under 35 U.S.C. §103(a) in view of the combination of Knorig and Termin et al. Regardless of what the Examiner intended to do, the forgoing comments indicate that a prima facie case of obviousness has not been properly established for any of the claims. Consequently, claims 13 and 25 are believed to be in condition for allowance.

Claims 2, 6, 15 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knorig in view of Termin et al. as applied to claims 1 and 13 above, and further in view of Mareiro et al. in U.S. Patent No. 6,258,099. As indicated above, claims 1 and 13 are believed to be patentable because a prima facie case of obviousness has not been properly established for these claims. Mareiro et al. fails to cure this deficiency. Accordingly, claim 1 and 13 are believed to be in condition for allowance. Because claims 2 and 6 depend from claim 1 and because claims 15 and 19 depend from claims 13, they are also patentable for this reason and because they add significant elements to distinguish them further from the art.

Claims 3 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knorig in view of Termin et al. as applied to claims 1 and 13 above, and further in view of Bradshaw in U.S. Patent No. 6,450,988. As indicated above, claims 1 and 13 are believed to be patentable because a prima facie case of obviousness has not been properly established for these claims.

Appl. No. 10/828,572
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Bradshaw fails to cure this deficiency. Accordingly, claim 1 and 13 are believed to be in condition for allowance. Because claims 3 and 16 depend from claims 1 and 13, respectively, they are also patentable for this reason and because they add significant elements to distinguish them further from the art.

Claims 4, 5, 17 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knorig in view of Termin et al. as applied to claims 1 and 13 above, and further in view of Grayzel et al. in U.S. Patent Pub. No. 2002/0010489. As indicated above, claims 1 and 13 are believed to be patentable because a prima facie case of obviousness has not been properly established for these claims. Grayzel et al. fails to cure this deficiency. Accordingly, claim 1 and 13 are believed to be in condition for allowance. Because claims 4 and 5 depend from claim 1 and because claims 17 and 18 depend from claims 13, they are also patentable for this reason and because they add significant elements to distinguish them further from the art.

Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Knorig in view of Termin et al. as applied to claim 9 above, and further in view of Campbell in U.S. Patent No. 5,928,193. As indicated above, claim 1 is believed to be patentable because a prima facie case of obviousness has not been properly established for it. Campbell fails to cure this deficiency. Accordingly, claim 1 is believed to be in condition for allowance. Because claim 10 depends from claim 1 it is also patentable for this reason and because it adds significant elements to distinguish it further from the art.

Claims 22-24, and 29-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knorig in view of Termin et al. For the reasons set forth above, Applicants respectfully submit that it is improper to combine Knorig with Termin et al. Consequently, a prima facie case of obviousness has not been properly established to reject claims 22-24, and 29-32 in view of these references.

Claims 33 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knorig in view of Amundson et al. in U.S. Patent No. 5,484,449. Much like the combination of Knorig and Termin et al., the combination of Knorig and Amundson et al. is improper. For example, nothing in the references themselves suggests any desirability to combine the teachings thereof to arrive at the claimed invention. Moreover, it is likely that changing the structured outer surface of the Knorig balloon so that it includes a stent (like stent 1 of Amundson et al.)

Appl. No. 10/828,572
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would cause the Knorig balloon to fail and, consequently, there would not be a reasonable expectation of success. Furthermore, the combination of the references, if deemed proper, would not teach or suggest all of the claim limitations. Therefore, Applicants respectfully submit that a prima facie case of obviousness has not been properly established and the rejection of claims 33-34 should be withdrawn in due course.

Conclusion

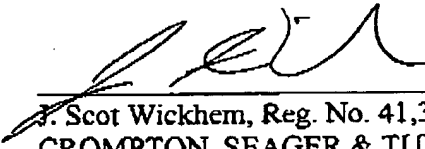
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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